Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY CHARLES DUNSMORE, STEVEN LEE HARRINGTON,
and MARK CHRISTAN SPEICH

Appeal No. 2003-1184
Application No. 09/737,344

ON BRIEF

Before JERRY SMITH, FLEMING, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10-14.

We affirm.

BACKGROUND

The invention is directed to a personal data assistant (PDA) watch having a dial for entering characters into the PDA. Representative claim 10 is reproduced below.

10. A PDA watch comprising:

a chassis;

data processing hardware mounted within the chassis and operable for running a software program;

a display device coupled to the data processing hardware for displaying output information from the software program, the display device mounted in the chassis so that the display device is viewable by a user of the PDA watch; and

an input dial mounted on the chassis, and operable for inputting alphanumeric characters into the software program, wherein the input dial is circular shaped with depictions of the alphanumeric characters lining a circumference of the input dial.

The examiner relies on the following references:

Laesser	4,044,242	Aug. 23, 1977
Numazaki	5,900,863	May 4, 1999
Wicks et al. (Wicks)	5,914,669	Jun. 22, 1999

Claims 10-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Numazaki and Wicks.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Numazaki, Wicks, and Laesser.

Claims 1-9 have been canceled. Claims 15-19 stand allowed.

We refer to the Final Rejection (Paper No. 7) and the Examiner's Answer (Paper No. 13) for a statement of the examiner's position and to the Brief (Paper No. 11) and the Reply Brief (Paper No. 14) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants argue that the motivation to combine the references is based solely on the subjective opinion of the examiner. Appellants' arguments for patentability thus rest on whether there is sufficient evidence to support the examiner's finding of a motivation to combine.[1]

There is no express suggestion in the references to make the proposed combination. That is, Numazaki does not say that the PDA watch may have an input dial. Wicks does not say that the input dial may be used on a PDA watch. However, the suggestion to combine need not be express and "may come from the prior art, as filtered through the knowledge of one skilled in the art." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1125, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (quoting Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997)).

[1] The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

The examiner finds (Answer at 4) that the input dial of Wicks had the obvious advantage of allowing a user to input and transmit a virtually unlimited range of messages using the character dial. The examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a character dial for input to a PDA watch for the purpose of effecting an unlimited number of inputs, thereby increasing the versatility and reliability of the watch device.

The text of Wicks at column 2, lines 5 through 9 provides support for the examiner's finding of motivation to combine the references. Wicks discloses that the character dial allows the pager user to input and transmit a virtually unlimited range of messages. We agree with the examiner that the artisan would have recognized the similarity in the problems attendant to inputting alphanumeric characters into a pager and inputting alphanumeric characters into a PDA watch. In our view, the examiner's opinion reflects the artisan's understanding of the references -- i.e., what the teachings would have meant to one skilled in the art -- rather than substituting for objective evidence in support of the ultimate conclusion of obviousness.

Appellants submit an apparent fall-back position in the Reply Brief. Appellants note that Numazaki teaches that the PDA watch has a non-contact input device, and conclude that the artisan would not have been motivated to use an input dial as taught by Wicks. However, the rejection (e.g., Answer at 3-4) makes clear that Numazaki is relied upon only for its showing of the basic components of a PDA watch, not for its teachings with respect to the particular input device. "'The use of patents as references

is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.'" In re Heck, 699 F.2d 1331, 1333, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Appellants' fall-back position is further undermined by appellants' admissions with respect to the prior art and by consideration of the problem that appellants set out to solve. According to appellants' description of prior art PDA watches (spec. at 1-2), characters were generally entered by scrolling through the alphabet using buttons on the side of a watch, making the entry of data difficult and tedious. Even if appellants could formulate an argument based on allegations of antithetical teachings in Numazaki and Wicks, it should be apparent to appellants that the input dial disclosed by Wicks represents an improvement over using buttons on the side of a watch to scroll through the alphabet.[2]

We sustain the rejection of representative claim 10. Appellants suggest (Brief at 4) that the claims subject to the rejection over Numazaki and Wicks are argued separately. However, we do not find any arguments specific to the subject matter of the dependent claims. Claims 11 and 12 thus fall with claim 10. See 37 CFR

[2] That appellants may not have had actual knowledge of the teachings of Wicks is not relevant in the instant inquiry. Knowledge of all prior art in the field of the inventor's endeavor and of prior art solutions for a common problem even if outside that field are attributed to the hypothetical "person having ordinary skill in the art" at the time the invention was made. In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

§ 1.192(c)(7). See also In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.").

With respect to the rejection of claim 14, appellants rely on the "same reasons as given above" -- i.e. the alleged lack of providing evidence in support of combining the teachings of Numazaki and Wicks -- to show error in the rejection. Since we find appellants' position to be untenable, and the examiner has set forth a reasonable case for prima facie obviousness of the subject matter as a whole of claim 14, we sustain the rejection over Numazaki, Wicks, and Laesser.

CONCLUSION

The examiner's rejection of claims 10-14 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH Administrative Patent Judge	)))))) BOARD OF PATENT
MICHAEL R. FLEMING Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	))))

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